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Respondent In Pro Per

UNITED STATES COPYRIGHT CLAIMS BOARD

DAVID G. OPPENHEIMER,

Claimant,

vs.

DOUGLAS A. PRUTTON.

Respondent.

CLAIM NUMBER: 22-CCB-0045

PARTY STATEMENT OF RESPONDENT DOUGLAS A. PRUTTON

I. STATEMENT OF FACTS

The claimant David G. Oppenheimer is the poster boy for copyright trolling in the United States. He claims to be a "professional photographer," but, in fact, he is a professional copyright troller. U.S. District Judge Richard Mark Gergel, in the case of David Oppenheimer v. Scarafile (D. S. Carolina), 2:19-CV-3590, noted in his opinion dated July 12, 2022 that the evidence showed that Mr. Oppenheimer "earned more than $400,000 from litigation settlements and less

than $5,000 from license and print sales in 2017." A search of PACER shows that Mr. Oppenheimer has filed 176 federal copyright infringement lawsuits across the country, most of them filed since 2016, including 31 in 2022.

Mr. Oppenheimer's modis operandi is simple but, as noted above, quite effective in generating income. He registers thousands of photographs and then he goes fishing. In the Scarafile case, noted above, Mr. Oppenheimer's deposition was taken. The transcript of that deposition was filed in support of defendant's summary judgment motion and can be found in the register of action of that lawsuit. Mr. Oppenheimer testified during that deposition that he uses various third party entities, including a website called Pixsy.com, to troll the internet for his photographs searching for infringers. The Pixsy website boasts of its ability to search the internet and: "Our team of copyright experts and international legal partners handle the whole infringement case process to recover fees and damages on your behalf. No win, no fee!" (Emphasis in original).

After locating potential infringers, the lawyers take over with extravagant demands for money. If the money is not paid, a federal lawsuit is commenced. The lawsuits result in a default (if the defendant fails to respond), or an eventual settlement. Mr. Oppenheimer testified in his deposition that not a single one of his lawsuits have gone to trial. With the exception of only one case (which Mr. Oppenheimer dismissed because the Judge made some type of ruling) all of the lawsuits have resulted in a settlement or a default.

I am a sole practitioner lawyer in Concord and I became ensnared in Mr. Oppenheimer's trolling activity. My adult daughter offered to improve my website and I, of course, had no objection. Among other things, she posted photos of Bay Area courthouses on a page of my website entitled 'Where We Work." Included was a photo of the federal courthouse in Oakland which apparently is plaintiff's photo.

When I received a letter in 2019 from an Arkansas attorney representing Mr. Oppenheimer, advising me that the photo was plaintiff's, I immediately removed the photo from my website. This attorney demanded $30,000.00. I offered $200.00. This attorney re-iterated Mr. Oppenheimer's demand for $30,000.00. I responded with an offer of $500.00. Mr. Oppenheimer then sued me in federal court in San Francisco asserting (1) a copyright infringement claim; and (2) a claim under the DMCA (Digital Millenium Copyright Act).

The federal case was scheduled for trial on May 16, 2022. I served a subpoena on Mr. Oppenheimer's attorney on March 29, 2022 demanding that Mr. Oppenheimer produce at trial documents regarding his income sources (from selling and licensing photographs and from copyright trolling). The next day, March 30, 2022, Mr. Oppenheimer's attorney emailed me suggesting that we agree to present the claim to the copyright claims board in lieu of trial, and that the DMCA claim and attorney's fee claims would be dropped, leaving only the copyright infringement claim. I stipulated to this procedure, but as can be discerned from Mr. Oppenheimer's statement filed with the Board, he is still demanding $30,000.00.

Mr. Oppenheimer in his "Party Statement" submitted to this Board has made numerous inaccurate statements under the heading 'Background." In particular he states (1) that I "scraped the Photograph from an Oppenheimer-authorized website" and (2) that I "cropped the image (removing one of the watermarks on the Photograph)."

There is no evidence that I (or my daughter) scraped the image "from an Oppenheimer authorized website." My daughter does not recall where she located the photograph on the internet, but Mr. Oppenheimer's photos can be found in many different locations on the internet. In his deposition in the Scarafile case, Mr. Oppenheimer testified that his photographs can be found on many different websites including Flickr, Photoshelter, Facebook, Fine Arts America,

Panoramic, Google maps, Picasa, Mobypicture, Linked In and Twitter, as well as on his own company's website Performance Impressions. (Pp. 72 -75).

There is also no evidence that I (or my daughter) cropped the image removing any watermark or copyright information. My daughter in her declaration clearly states that she would not have cropped the image to remove any copyright or watermark. Further, Mr. Oppenheimer's photograph of the Oakland federal courthouse can easily be found on the internet without any watermark or copyright information on the image. For example, on March 25, 2021 I performed a Google search for images of the Oakland federal courthouse. Attached as Exhibit D to my Declaration is a print-out from that search showing Mr. Oppenheimer's photograph on Google, but with no watermark or copyright information shown.

Also of note, I have attached as Exhibits B and C to my declaration the image of the Oakland federal courthouse that is included in the "My Photos" portion of my GoDaddy account. GoDaddy is the company I use to create and manage my website. The image does not include any watermark or copyright information.

Perhaps most importantly, regarding the issue of "cropping," a careful comparison of the image downloaded to my GoDaddy account and the image that included Mr. Oppenheimer's copyright information, shows that the image downloaded to my GoDaddy account was not cropped from this other image. In the bottom right corner of the image downloaded to my GoDaddy account (shown in Exhibit C) there are 9 vertical columns (one set of five, and one set of four) topped by headers. However, in Mr. Oppenheimer's copyrighted image, the words "(c) 2017 David Oppenheimer" are imprinted in the lower right corner directly over these columns. In fact, these two images appear identical except that the image downloaded to my GoDaddy account does not include the copyright information in the lower right corner. This proves that the copyright image was not "cropped" in the sense that it was reduced in size so that the lower

right corner of the photo, with the copyright information, was removed. The only other way the copyrighted image could have been "cropped" would have been if it was somehow removed from the image, but I am unaware if that type of removal is even possible, and my daughter in her declaration has stated that she does not know if such a removal was possible. Moreover, why would my daughter and I go through the process of removing the copyright information when there are literally hundreds of other non-copyrighted photos of the Oakland federal courthouse available on the internet?

II. LAW AND ARGUMENT

As noted above, the issue before this Board consists of a single copyright infringement violation. The DMCA claim that Mr. Oppenheimer had asserted in the federal lawsuit (which would have required proof that I or my daughter intentionally removed or altered copyright information, or distributed the photograph knowing that any such information had been removed or altered) and the attorney's fees claim have been dropped.

For purposes of this proceeding I admit that Mr. Oppenheimer's photograph was posted on my website. Contrary to Mr. Oppenheimer's assertion, I am not claiming that I am somehow shielded from responsibility because it was my daughter, not I, who posted the photograph on my website. However, this does not mean that I am without a defense (as asserted by Mr. Oppenheimer). In fact, I have two defenses that operate as a complete bar to Mr. Oppenheimer's copyright infringement claim: (1) fair use; and (2) unclean hands. Ironically, both of these defenses have been successfully asserted in cases brought by Mr. Oppenheimer.

(a) Fair Use Defense

Mr. Oppenheimer filed a lawsuit in North Carolina (where he resides) entitled Oppenheimer v. The ACL LLC, 504 F.Supp.3d 503 (W.D. North Carolina, 2020). In that case, the defendant posted one of Mr. Oppenheimer's photos of a casino on its website promoting a cornhole tournament. Mr. Oppenheimer filed a summary adjudication motion regarding the copyright infringement claim and several affirmative defenses raised by the defendant, including the fair use defense and unclean hands. The court (Judge Graham C. Mullen) denied Mr. Oppenheimer's motion as to the fair use defense and unclean hands. The Court noted that if the defendant's use of the casino photo was "fair," plaintiff's copyright infringement claim would be barred. The Court noted that the law requires a consideration of several factors in determining whether there was a "fair use" of a copyrighted photo, the "single most important element" being "whether the secondary use usurps the market of the original work."

Judge Mullen denied Mr. Oppenheimer's motion as to the fair use defense reasoning as follows: "Nevertheless, when turning to the final factor, it seems that Plaintiff has failed to establish sufficient undisputed facts to support the effect Defendants' use had upon the potential market for or value of the copyrighted work. While Plaintiff argues he is a professional photographer and his income is derived from licensing his works, Defendant argues his income is derived from copyright infringement cases. Without more facts, perhaps those attesting to the value of the photograph, the expected profit from the photograph, or even the value or expected profits derived from similar photographs, the Court cannot make a determination as to the fourth factor of the fair use doctrine. Plaintiff has not established sufficient facts that the secondary use usurped the market for the original work. While the Court acknowledges that these factors are to be examined as a whole and no single factor is determinative, the fourth factor is undoubtedly the most important factor. A reasonable jury could find that the Defendants' use of the work had minimal effect upon the potential market for or value of the copyrighted work and this would be

key to analysis of the substantive law." 504 F.Supp.4th at 511. In the present case, defendant is unable to show that the posting of his photo on a rather obscure page on my website had any effect on the potential market for or value of his photograph, or that it usurped the market for the original photo. In discovery in the federal case brought against me by Mr. Oppenheimer he admitted that he has not sold or licensed a single copy of the photo in question.

The fair use defense was also addressed by a different Judge in the case of Oppenheimer v. Scarafile (D.C. South Carolina 2021), 2:19-cv-3590. On July 17, 2022, Judge Gergel issued an opinion agreeing with Judge Mullen in the ACL, LLC case that: "the fourth factor is considered the "single most element of fair use," and looks to "whether the secondary use *usurps the market of the original work*." *Id.* at 643 (quoting *NXIVM Corp. v. The Ross Inst.*, 364 F.3d 471, 482 (2d Cir. 2004)) (emphasis in original). In denying Mr. Oppenheimer's summary judgment motion, Judge Gergel explained: "the evidence in this case shows that Plaintiff derives a large majority of his income from copyright infringement cases. Considering that evidence and the absence of facts regarding the value of the photographs or the expected profit from the photographs, the Court cannot make a determination as to the fourth factor of the fair use doctrine. Plaintiff has not established sufficient facts that the secondary use usurped the market for the original work. While the Court acknowledges that these factors are to be examined as a whole and no single factor is determinative, the fourth factor is undoubtedly the most important factor. A reasonable jury could find that Defendants' use of the work had minimal effect upon the potential market for or value of the copyrighted work."

In the present case, under the circumstances, my posting of Mr. Oppenheimer's photo on an obscure page on my website had "minimal effect upon the potential market for or value of the copyrighted work", which is a complete defense to the copyright infringement claim.

(b) Unclean Hands

This complete defense to a copyright infringement claim, was also addressed by the court in the ACL, LLC case. Judge Mullen ruled regarding the unclean hands defense: "If Plaintiff's [Mr. Oppenheimer's] purpose in copyrighting the Copyrighted Work was to license it for use when individuals or companies need a photo of the Harrah's lobby, then Plaintiff is likely not misusing his copyrights. Yet, a reasonable jury *could* find Plaintiff is using copyrights to derive an income from infringement suits and this issue is one of fact that the Court should not decide." 504 F.Supp.4th at 512. In the present case, the Board is basically acting like a jury - the facts show that Mr. Oppenheimer is "using copyrights to derive an income from infringement suits," and, thus, his claim should be barred by the unclean hands defense.

A somewhat related defense addressed in the Scarafile case involves the "misuse defense." The Judge has this to say about this defense and Mr. Oppenheimer:
"The misuse defense may exist, however, if a copyright owner is more focused on the business of litigation than selling a product or licensing their copyrights to third parties. *See Oppenheimer v. The ACL LLC*, (W.D. N.C. 2020) (denying plaintiff's summary judgment on defendant's misuse defense because a reasonable jury could find plaintiff using copyrights to derive an income from infringement suits). The misuse defense may also exist if the copyright owner employs abusive litigation tactics to extract settlements. *See Harrington*, 2022 WL 1567094, at *3 (denying plaintiff's motion to dismiss defendant's misuse defense because defendant alleged more than the mere fact that plaintiff files or threatens to file cases to enforce his copyright, such as abusive litigation tactics and demanding settlements well in excess of the damages)."

In the present case, Mr. Oppenheimer has consistently demanding $30,000.00 from me, an amount well in excess of any damages. I attempted to engage in settlement negotiations, but Mr.. Oppenheimer would not budge. Fortunately I am a civil litigator and can defend myself. But, for other defendants who cannot represent themselves, consider the predicament. If they do

not cave-in to Mr. Oppenheimer's oppressive demands they face a federal lawsuit. In order to defend themselves they would need to hire an attorney and the cost of hiring that attorney would likely exceed the amount of Mr. Oppenheimer's demand. Moreover, they are faced with a claim for attorney's fees.

(c) Statutory Damages

Should the Board conclude that Mr. Oppenheimer is entitled to statutory damages, I would request that the damage award be the absolute minimum permitted. I suggest that the award be in the amount of $200.00 pursuant to 17 USC 504(c)(2) which provides in pertinent part: "In a case where the infringer sustains the burden of proving, and the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than $200." As discussed above, neither my daughter nor I were aware of or had reason to believe that the photo downloaded from the internet was Mr. Oppenheimer's photo.

Should the Board conclude that the $200.00 award is inapplicable, I would suggest that the $750.00 minimum award be granted pursuant to 17 USC 504(c)(1). Another Oppenheimer case supports this position. In Mr. Oppenheimer's backyard in the Western District of North Carolina, District Judge Martin Reidinger issued a Memorandum of Opinion on December 31, 2019 in the case of Oppenheimer v. Griffin, 18-cv-00272-MR. The defendants in that case defaulted and Judge Reidinger in his opinion was addressing the issue of the appropriate remedies for the default judgment. Of note, he concluded that only the minimum statutory damages should be awarded for the copyright infringement and violation of the DMCA. Noting Mr. Oppenheimer's numerous filings in North Carolina alone, Judge Reidinger concluded that his decision was "consistent with a recent trend in courts across the country ... to award the minimum statutory award of $750 per violation in infringement cases brought by copyright

holders who seek copyright infringement damages not to be made whole, but rather as a primary or secondary revenue stream."

Judge Reidinger exercised his discretion and rejected Mr. Oppenheimer's claim for attorney's fees. He reiterated that "the Plaintiff's motive in bringing this claim does not support an award of attorney's fees and costs because the Plaintiff appears to be using the copyright laws as a source of revenue, rather than as redress for legitimate injury."

A Judge in South Carolina had this to say in another lawsuit where Mr. Oppenheimer was arguing that information about his income sources was irrelevant: "In determining an appropriate award of damages in a copyright infringement lawsuit, courts routinely consider the extent to which the plaintiff has engaged in "copyright trolling." As the Seventh Circuit explained, "copyright trolls" are "opportunistic holders of copyrights" that "bring[ ] strategic infringement claims of dubious merit in the hope of arranging prompt settlements with defendants who would prefer to pay modest or nuisance settlements rather than be tied up in expensive litigation." Design Basics, LLC v. Lexington Homes, Inc., 858 F.3d 1093, 1097 (7th Cir. 2017). "Like the proverbial troll under the bridge, these firms try to extract rents from market participants who must choose between the cost of settlement and the costs and risks of litigation." Id. Courts routinely factor a copyright plaintiff's status as a copyright troll into their damages calculus. See, e.g., ME2 Prods., Inc. v. Ahmed, 289 F. Supp. 3d 760, 764 (W.D. Va. 2018). Many courts have determined that minimum statutory damages are appropriate where the plaintiff is a "copyright troll" who "seek[s] copyright infringement damages not to be made whole, but rather as a primary or secondary revenue stream and [who] file[s] mass lawsuits ... with the hopes of coercing settlements." Id. (quoting Malibu Media, LLC v. [Redacted], 2017 WL 633315, at *3 (D.' Oppenheimer v. Williams, 2:20-cv-4219.

III. CONCLUSION

About 3 ½ years have elapsed since Mr. Oppenheimer, through his various attorneys, have demanded I fork over $30,000.00 in order to put an end to this pursuit against me. I am not a copyright lawyer, but I cannot imagine how there could be a smaller case. My daughter innocently downloaded a photo of a courthouse on the internet that did not include any identifying marks. The photo was placed on an obscure part of my website, along with photos of other courthouses, which could only be seen if someone clicked on the "Where We Work" link. When I learned that the photo was Mr. Oppenheimer's I immediately removed it from my website.

The federal district courts have consistently done what they can to limit Mr. Oppenheimer's trolling by awarding minimum damages in default cases, denying Mr. Oppenheimer's summary judgment motions, compelling Mr. Oppenheimer to produce information about his trolling, and denying his claims for attorney's fees. Defendants though end up settling with Mr. Oppenheimer, creating a huge income for him, because the cost of fighting is prohibitive. Hopefully this Board will do what it can to stop Mr. Oppenheimer, who is most likely using this claim as a test to see if he can efficiently make more money going through the Board.

This is not about protecting legitimate copyright holder rights. I am an artist myself (signer/songwriter) and I fully support artists in protecting their works. This is about the misuse of copyright laws and the misuse of the legal process which I as a lawyer detest.

Dated: 1/10/2023

Douglas A. Prutton
Respondent In Pro Per

Proof of Delivery

I hereby certify that on Tuesday, January 10, 2023, I provided a true and correct copy of the Party Statement of Respondent Douglas A. Prutton to the following:

David G Oppenheimer, represented by Lawrence G Townsend, served via ESERVICE at ltownsend@owe.com

Signed: /s/ Douglas A Prutton